

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT of William Possidento

Docket: WP71611

Patent No: 6,342,127

Issue Date: 01/29/2002

Application No.: 08/940203

Filed: 09/29/1997

For: Distillation device

Commissioner of Patents and Trademarks


P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

TRANSMITTAL LETTER

Please accept the following for filing:

1. Petition to revive a lapsed patent, 3 pages.
2. Check for \$1450 to cover the fees.


Alfred F. Hoyte, Jr.
Reg. No. 33,512
Tel. No. 202-737-7590

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Petition for Reconsideration under 37 CFR 1.378(e)

1. The petition for reconsideration under 37 CFR 1.378(e) of the above mentioned patent having been dismissed a second time, Petitioner hereby files for reconsideration.

As stated in the initial petition, this patent became lapsed unavoidably. Petitioner Possidento had relied on his former Patent attorney, John Halvonik, to keep him abreast of the scheduling of maintenance fees for the above mentioned patent. Halvonik's registration was suspended in 2005, and from 11/06 to the present. Possidento was unaware that Mr Halvonik's registration was suspended and did not receive correspondence from the USPTO as his (applicant's) address was not listed as the correspondence address. Possidento did not receive notice regarding the issue fee from Halvonik. Accordingly, Mr. Possidento was not aware that the patent had lapsed.

Patentee became aware that the patent had expired in late September of 2011. Petitioner was in the practice of searching the internet to view the status of his patent not realizing that the database which he was using did not show this information. Petitioner did exercise diligence in maintaining the patent, but was unaware that the maintenance fee database on the USPTO website was the proper digital venue. As some time had passed since Mr. Halvonik had contacted him, he decided to contact Halvonik to determine the maintenance fee status. At this point Halvonik informed him of his suspension and told him his patent had expired.

In dismissing the petition, the USPTO states, inter alia, that petitioner must show that he was aware of the need to pay the maintenance fee, and was engaged in tracking the fee by some means. However, the petitioner has stated that he had engaged Mr. Halvonik to track the fee which clearly establishes that he was aware of the need to pay the fee. Furthermore, Mr. Halvonik, being suspended at least for the time the when the fee could have been paid under the unintentional standard, and not currently in practice at that time, was unavoidably prevented from making the payment after his suspension. The only thing Mr. Halvonik could have done would have been to contact Petitioner, but Mr. Halvonik was not currently in practice at that time and did not do so.

After discussing the matter with Mr. Halvonik, it appears that he (Halvonik) had in fact been tracking the maintenance fee. Mr. Halvonik has further stated that he did in fact receive a notice from the PTO regarding the fee, but did not further the notice to applicant as he was of the opinion that any client contact could be construed as unauthorized practice of law and jeopardize his case for reinstatement. That Mr. Halvonik had received the notice is a matter of USPTO record and accordingly no showing of that need be made. While the details of Mr. Halvonik's tracking system are not known, what is known is that Mr. Halvonik became aware of the due date of the maintenance fee using the system, and failure of the system was not the reason Petitioner missed the due date.

The USPTO, in its second dismissal in this matter relies almost solely on the well established standard that acceptance of late payment of the fee under the unavoidable standard must include a showing that a reliable tracking system was in place, and that in order for the petition to be granted pursuant to 1.378(b)(3), evidence must be provided that the system, or more particularly, failure of the system in some regard is what caused the delay. However, failure of the tracking system in the instant case was not the cause of the delay.

The USPTO further states that there is nothing in the record to establish that the attorney (Halvonik) had steps in place to ensure the fee was paid on time. The petitioner, in light of the above, can now establish that Mr. Halvonik did in fact have a system in place at the relevant time. Even if Mr. Halvonik's system was as simple as relying on the PTO to send a notice, if the PTO did in fact send the notice and Mr. Halvonik did receive the notice, it cannot be reasonably stated that the lack of a reliable tracking system was the reason for the delay. In fact, the sole reason for the delay was Mr. Halvonik's failure to communicate with the Petitioner regarding the fee, which failure, Mr. Halvonik reasonably believed, was appropriate given his suspended status.

It should also be noted again that the PTO has accepted delayed payment in several cases with similar fact patterns. For example, In re Patent No. 6,000,448 (Mar. 21, 2006) (Docket # 17, Decl. of Donald R. Steinberg in support of Pl.'s Cross-Mot. for Summ. Judgment, Ex. X) (finding unavoidable delay where the patent holder had not paid the maintenance fee, *was unaware of his obligation to do so*, and could not locate his attorney during the relevant time period(emphasis added)). Indeed, it is well established that there are circumstances where the action or non-action of a patentee's representative has resulted in a patentee meeting the unavoidable standard. See also, In re Patent No. 6,160,836 (Apr. 2, 2007) (Docket # 17, Ex. 5) (PTO found unavoidable delay where patent holder's attorney failed to forward the required payment to the PTO, and had been suspended from practicing before the PTO; reasoned "[g]iven the facts and circumstances of this case, in particular the suspension of petitioner's prior attorney, it is concluded that petitioner, has established that the delayed payment of the maintenance fee was unavoidable"); In re Patent No. 5,455,569 (Mar. 4, 2003) (Docket # 17, Ex. 4) (concluding that the patent holder had demonstrated unavoidable delay); and In re Patent No. 5,125,742 (Feb. 25, 1999) (Docket # 17, Ex. 6) (same). CIVIL ACTION NO. 08-12119-RWZ, SPRINGUARD TECHNOLOGY GROUP INC.v.UNITED STATES PATENT AND TRADEMARK OFFICE, *et al.* (UNITED STATES DISTRICT COURT


DISTRICT OF MASSACHUSETTS)

In the instant case, Petitioner can establish that he did engage someone to track the maintenance fee, the fee was tracked by some kind of tracking system, and the person tracking the fee was aware that the fee was due. Even if Mr. Halvonik had an elaborate tracking system in place, replete with calendars and a secretarial staff to provide an evidentiary record for this petition, the date would surely have been missed whether the reliable tracking system failed or not because Mr Halvonik simply was not going to contact Petitioner. The common theme in the above mentioned cases concerning disbarred or suspended attorneys is not whether a reliable tracking system was in place, but whether failure of the disbarred attorney to act rises to the unavoidable standard.

The USPTO also cites Link v. Wabash 370 U.S. 626 633-634 (1962) and other cases which establish that the action, inaction, or negligence of a duly represented agent is imputed to the applicant. However, none of those cases involve a disbarred or suspended attorney or agent who is not able to act on behalf of the applicant as in the instant case.

Accordingly, it is believed that the Director should grant the petition for reconsideration and accept the enclosed maintenance fee payment.

2. Enclosed please find a check for \$1450.00 to pay the second maintenance fee.


SIGNATURE OF ATTORNEY
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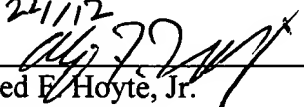
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CERTIFICATE OF MAILING

I hereby certify that this correspondence will be deposited with the United States Postal Service by First Class Mail, postage prepaid, in an envelope addressed "Commissioner of Patents and Trademarks, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450 " on the date below.

Date: 12/24/12


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